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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/509,885

Applicant(s)

PERVAN, DARKO

Examiner

CHRISTOPHER J. DARNER

Art Unit

3633

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-98 is/are pending in the application.
- 4a) Of the above claim(s) 70-75 and 93-98 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-69 and 76-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 01/29/2008 and 01/25/2005 and 06/29/2005 and 07/27/2007
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 53-69, 76-92, drawn to a floor board, classified in class 52, subclass 592.1.
 - II. Claims 70-75, 93-98, drawn to method for manufacturing a floor board, classified in class 29.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case floorboards are bolted and then welded together.
3. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:
 - (a) the inventions have acquired a separate status in the art in view of their different classification;

- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. This application contains claims directed to the following patentably distinct species Figure 9a through Figure 14d and Figure 15a through 17 and Figure 36a through Figure 36f, Figure 18a through Figure 18d, Figure 35a through Figure 35e, Figure 19a through Figure 19d, Figure 20a through Figure 23. The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Figure 9a is generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or

employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the

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prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

5. During a telephone conversation with Travis Boone on April 21, 2008 a provisional election was made without traverse to prosecute the invention of I, claim 53-69, 76-92, Figure 9a through Figure 14d and Figure 15a through 17 and Figure 36a through Figure 36f. Affirmation of this election must be made by applicant in replying to this Office action. Claims 70-75 93-98 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 53, 54, 58, 58, 61, 63, 64, 66, 67, 68, 69, 86, 77, 89, 90, 91, 92, 81, 82, 87, and 84 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16, 18-21, and 23-25 of U.S. Patent No. 7,051,486 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are substantially similar as follows:

10/509885

53

63, 86

54, 77

66, 89

67, 90

68, 91

69, 92

58, 81

59, 82

10/413478

1, 3, 4, 10, 15

2

5

6, 11, 18, 23

7, 19

8, 20

9, 21

12, 24

13, 25

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64, 87 14

61, 84 16

This is a nonstatutory obviousness-type double patenting rejection.

It appears that the applicant has filed numerous applications that address substantially similar limitations (if not identical embodiments) which would be a serious burden on the examiner to write a double patenting rejection over the course of the entire family. The applicant is respectfully requested to provide a clear line of demarcation among the following applications: 11/822688, 10/509885, 10/768677, 10933539, 10925924, 10/413478, 10/043149, 10/256167, 10/043424, 09/954066, 10/933539, 10256167, 10/043149, 10/043424, and 09/954066.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 63-65 recites the limitation "wood-based material" in line 1. There is insufficient antecedent basis for this limitation in the claim.

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10. Regarding claims 64 and 87, the phrase "and/or" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 53-60, 66, 76-83, and 89 are rejected under 35 U.S.C. 102(b) as being anticipated by Martensson (U.S. Patent # 6,763,643).

With respect to claims 53 and 76, Martensson discloses a floor board comprising connecting means integrated with the floorboard (1) and adapted to connect the floorboard with an essentially identical floorboard (1), wherein upper joint edges of said floorboard and said essentially identical floorboard in a connected state define a vertical plane, said connecting means adapted to connect said floorboard with said essentially identical floorboard in at least a horizontal direction perpendicular to said vertical plane, said connecting means comprising a locking strip (10) which projects from said vertical plane and carries a locking element which is adapted to cooperate, in said connected

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state, with a downward open locking groove (4) of said essentially identical floorboard, said locking strip is a separate part which is mechanically fixed to the floorboard in said horizontal direction and a vertical direction, wherein said locking strip is mechanically fixed to the floorboard at a joint (4') by snapping-in, inward angling, or frictional forces, Said locking strip comprising a strip tongue (10'), said locking strip adapted for connecting the floorboard with the essentially identical floorboard by at least inward angling, wherein the joint comprises a strip groove (4') adapted to receive the strip tongue and wherein the joint is open in the horizontal direction, the strip groove adapted for retaining the strip tongue in the strip groove when the strip groove is arranged in connection to the strip tongue in Figure 2c.

With respect to claims 54 and 77, Martensson discloses the floorboard wherein said connecting means are adapted for connecting the floorboard with the essentially identical floorboard by snapping-in in an essentially horizontal direction at column 7, lines 27-32.

With respect to claims 55 and 78, Martensson discloses the floorboard wherein said connecting means are adapted for disconnecting said floorboard from said essentially identical floorboard by an angular motion in a direction opposite to a direction of the inward angling in Figure 2c.

With respect to claims 56 and 79, Martensson discloses the floorboard further comprising a tongue groove (12') for connecting the floorboard to said essentially identical floorboard in a vertical direction perpendicular to a principal plane of the floor board, wherein the tongue groove is adapted for receiving a tongue (6) arranged on

said essentially identical floorboard, wherein at least one surface of said tongue groove is said locking strip (12) in Figure 2c.

With respect to claims 57 and 80, Martensson discloses the floorboard further comprising a locking surface arranged in said locking groove (4') and adapted to cooperate with a locking surface arranged on said locking strip (10') in Figure 2c.

With respect to claims 58 and 81, Martensson discloses the floor board wherein said locking surface arranged in the locking groove is arranged on a lower lip which defines said strip groove (4'), and wherein said locking surface arranged on the locking strip is arranged on a lower surface of said locking strip in Figure 2c.

With respect to claims 59 and 82, Martensson discloses the floorboard wherein the locking strip is detachable from said floorboard by an angular motion in a direction opposite to a direction of the inward angling in Figure 2c.

With respect to claims 60 and 83, Martensson discloses the floorboard wherein the locking strip is inserted into said strip groove arranged in an edge portion of said floorboard, wherein the locking strip is held in place in said horizontal direction by frictional forces in Figure 2c.

With respect to claims 66 and 89, Martensson discloses the floorboard wherein the floorboard is quadrilateral and along at least two mutually perpendicular edge portions has first and second sets of connecting means at column 6, lines 29-33.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 61-63 and 84-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (U.S. Patent # 6,763,643) in view of Laramore (U.S. Patent # 4,512,131).

With respect to claims 61 and 84, Martensson does not teach the floorboard wherein the locking strip is inserted into said strip groove arranged in an edge portion of said floorboard, wherein the locking strip is held in place in said horizontal direction by frictional forces and glue. Laramore teaches the floorboard wherein the locking strip (52) is inserted into said strip groove (54) arranged in an edge portion of said floorboard, wherein the locking strip is held in place in said horizontal direction by frictional forces and glue at column 4, lines 40-44. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Martensson to include the floorboard wherein the locking strip is inserted into said strip groove arranged in an edge portion of said floorboard, wherein the locking strip is held in place in said horizontal direction by frictional forces and glue as taught by Laramore in order to prevent the locking strip from disconnecting from the floorboards.

With respect to claims 62 and 85, Martensson does not teach the floorboard wherein the locking strip is made of essentially wood-based material. Laramore teaches the floorboard wherein the locking strip is made of essentially wood-based material at column 4, lines 52-57. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Martensson to include the floorboard wherein the locking strip is made of essentially wood-based material as taught by Laramore in order to provide greater stability from the standpoint of shrinkage.

With respect to claims 63 and 86, Martensson does not teach the floorboard wherein said wood-based material is selected from the group consisting of pure wood, particle board, plywood, HDF, MDF, and compact laminate. Laramore teaches the floorboard wherein said wood-based material is selected from the group consisting of pure wood, particle board, plywood, HDF, MDF, and compact laminate at column 4, lines 55-57. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Martensson to include the floorboard wherein said wood-based material is selected from the group consisting of pure wood, particle board, plywood, HDF, MDF, and compact laminate as taught by Laramore in order to provide greater stability from the standpoint of shrinkage.

10. Claims 64 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (U.S. Patent # 6,763,643) as applied to claim 53 above, and further in view of Moriau et al. (U.S. Patent # 7,040,068).

With respect to claim 64, Martensson does not teach the floorboard wherein said wood-based material is impregnated and/or coated with a property-improving agent. Moriau teaches the floorboard wherein said wood-based material is impregnated and/or coated with a property-improving agent at column 13, lines 24-29. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Martensson to include the floorboard wherein said wood-based material is impregnated and/or coated with a property-improving agent as taught by Moriau in order to protect the locking strip from wear.

11. Claims 65 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (U.S. Patent # 6,763,643) as applied to claim 53 above, and further in view of Haid (U.S. Patent # 4,599,841).

With respect to claim 65, Martensson does not teach the floorboard wherein said wood-based material comprises a curing polymer material. Haid teaches the floorboard wherein said wood-based material comprises a curing polymer material at column 3, lines 40-44. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Martensson to the floorboard wherein said wood-based material is impregnated and/or coated with a property-improving agent as taught by Moriau in order to protect the locking strip from wear. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Martensson to include the floorboard wherein said wood-based material

comprises a curing polymer material as taught by Haid in order to prevent the locking strip from cracking or fracture breakage.

14. Claims 67-69 and 90-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (U.S. Patent # 6,763,643) in view of Imus et al. (U.S. Patent # 6,901,709).

With respect to claims 67 and 90, Martensson does not teach the floorboard wherein said first set of connecting means is arranged on a short side of the floorboard and said second set of connecting means is arranged on a long side of the floor board, said first set of connecting means differing from said second set of connecting means in terms of material property or material composition. Imus teaches the floorboard wherein said first set of connecting means (44a, 44b) is arranged on a short side of the floorboard and said second set of connecting means (52a-c) is arranged on a long side of the floor board, said first set of connecting means differing from said second set of connecting means in terms of material property or material composition at column 5, lines 21-6, lines 41-43 and lines 53-59. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Martensson to include the floorboard wherein said first set of connecting means is arranged on a short side of the floorboard and said second set of connecting means is arranged on a long side of the floor board, said first set of connecting means differing from said second set of connecting means in terms of material property or material composition as taught by Imus in order to provide different connection points for the floorboard.

With respect to claim 68 and 91, Martensson in view of Imus discloses the claimed invention except for wherein a locking strip included in said first set of connecting means differs in terms of material property or material composition from a locking strip included in said second set of connecting means. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a different material composition to satisfy a particular need for either the first set locking strip or second set locking strip, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material.

With respect to claim 69, and 92, Martensson in view of Imus discloses the claimed invention except for wherein a locking strip included in said first set of connecting means has higher strength than the locking strip included in said second set of connecting means. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a different material composition to satisfy a particular need such as strength characteristic for either the first set locking strip or second set locking strip in order to improve the strength of the locking strip connection on either the first set or second set connecting means, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. It is also

common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pervan (U.S. Patent # 6,182,410) teaches systems for joining building boards, Civelli (U. S. Patent # 5,577,357) teaches half log siding mounting system, Palsson (U.S. Patent # 6,591,568) teaches flooring material and Porter (U.S. Patent # 5,950,389) teaches splines for joining panels.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER J. DARNER whose telephone number is (571)270-3658. The examiner can normally be reached on Monday thru Friday 7:30AM to 4:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian V. Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher J. Darner
/Basil Katcheves/
Primary Examiner, Art Unit 3635